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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,602	03/05/2002	David Arthur Berkley	2685/5944	7682
23838	7590	11/30/2005	EXAMINER	
KENYON & KENYON 1500 K STREET NW SUITE 700 WASHINGTON, DC 20005			FOX, JAMAL A	
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			2664	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,602

Applicant(s)

BERKLEY ET AL.

Examiner

Jamal A. Fox

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some ^ c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- ^ See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it is not within the range of 50 to 150 words. Correction is required. See MPEP § 608.01(b).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-101 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-89 of U.S. Patent No. 6,546,005. Although the conflicting claims are not identical, they are not patentably distinct from each other because the active user registry system of claims 1-89 of U.S. Patent No. 6,546,005 are broader than the active user registry system of claims 1-101 of the instant application.

Referring to claim 1, Application No. 10090602 claim 1 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

- a. a computer; and
- b. a database, linked to the computer,

containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred communications options;

wherein the system determines a communications address for contacting the user in accordance with a comparison between a communications option accompanying the request and the user's preferred communications options. U.S. Patent No. 6,546,005 claim 1 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

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- a. computer;
 - b. a database, linked to the computer, containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred communications options;
 - c. a voice interface for enabling interaction with, and control and management of, the system from any available voice-compatible communication interface; and
 - D. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database, the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database;
- wherein the system determines a communications address for contacting the user by brokering a communication in accordance with a comparison between a communications option accompanying the request and the user's preferred communications option.

Application No. 10090602 claim 1 does not claim

- c. a voice interface for enabling interaction with, and control and management of, the system from any available voice-compatible communication interface; and

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D. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database, the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit from claim 1 of U.S. Patent No. 6,546,005

c. a voice interface for enabling interaction with, and control and management of, the system from any available voice-compatible communication interface; and

D. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database, the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database because the scope of U.S. Patent No. 6,546,005 claim 1 is broader than claim 1 of the instant Application No. 10090602.

Referring to claims 2-16, Application No. 10090602 claims 2-16 are identical to claims 2-16 of U.S. Patent No. 6,546,005.

Referring to claim 17, Application No. 10090602 claim 17 recites the system according to claim 1, further comprising a voice interface for enabling interaction with, and control and management of, the system from any available voice-compatible

communication interface. U.S. Patent No. 6,546,005 claim 1 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

c. a voice interface for enabling interaction with, and control and management of, the system from any available voice-compatible communication interface. Therefore claim 1 of U.S. Patent No. 6,546,005 includes the limitation of claim 17 of the instant Application No. 10090602.

Referring to claim 18, Application No. 10090602 claim 18 recites the system according to claim 1, further comprising a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database. U.S. Patent No. 6,546,005 claim 1 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

D. **a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database**, the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database. Therefore, claim 18 of Application No. 10090602 includes the limitation of claim 1 of U.S. Patent No. 6,546,005.

Referring to claim 19, Application No. 10090602 claim 19 recites the system according to claim 18, wherein the information stored in the cache for a particular

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subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database. U.S. Patent No. 6,546,005 claim 1 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

D. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database, **the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database.**

Therefore, claim 19 of Application No. 10090602 includes the limitation of claim 1 of U.S. Patent No. 6,546,005.

Referring to claim 20, Application No. 10090602 claim 20 is identical to claim 17 of U.S. Patent No. 6,546,005.

Referring to claim 21, Application No. 10090602 claim 21 is identical to claim 18 of U.S. Patent No. 6,546,005.

Referring to claim 22, Application No. 10090602 claim 22 is identical to claim 19 of U.S. Patent No. 6,546,005.

Referring to claim 23, Application No. 10090602 claim 23 is identical to claim 20 of U.S. Patent No. 6,546,005.

Referring to claim 24, Application No. 10090602 claim 24 is identical to claim 21 of U.S. Patent No. 6,546,005.

Referring to claim 25, Application No. 10090602 claim 25 is identical to claim 22 of U.S. Patent No. 6,546,005.

Referring to claim 26, Application No. 10090602 claim 26 is identical to claim 23 of U.S. Patent No. 6,546,005.

Referring to claim 27, Application No. 10090602 claim 27 is identical to claim 24 of U.S. Patent No. 6,546,005.

Referring to claim 28, Application No. 10090602 claim 28 is identical to claim 25 of U.S. Patent No. 6,546,005.

Referring to claim 29, Application No. 10090602 claim 29 is identical to claim 26 of U.S. Patent No. 6,546,005.

Referring to claim 30, Application No. 10090602 claim 30 is identical to claim 27 of U.S. Patent No. 6,546,005.

Referring to claim 31, Application No. 10090602 claim 31 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

- a. a computer; and
- b. a database, linked to the computer, containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred communications options;

wherein information corresponding to the user's preferred communications options is automatically learned in accordance with how the user interacts with

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communication attempts from other persons. U.S. Patent No. 6,546,005 claim 28 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

- a. a computer;
 - b. a database, linked to the computer, containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred communications options; and
 - c. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database;
- wherein information corresponding to the user's preferred communications options is automatically learned in accordance with how the user interacts with communication attempts from other persons and wherein the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database.

Application No. 10090602 claim 31 does not claim

- c. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database; and

wherein the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit from claim 28 of U.S. Patent No. 6,546,005

c. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database; and

wherein the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database because the scope of U.S. Patent No. 6,546,005 claim 28 is broader than claim 31 of the instant Application No. 10090602.

Referring to claims 32-40, Application No. 10090602 claims 32-40 are identical to claims 29-37 respectively of U.S. Patent No. 6,546,005.

Referring to claim 41, Application No. 10090602 claim 41 recites the system according to claim 31, further comprising a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database. U.S. Patent No. 6,546,005 claim 28 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

c. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for

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contacting the user stored in the database. Therefore, claim 28 of U.S. Patent No. 6,546,005 includes the limitation of claim 41 of Application No. 10090602.

Referring to claim 42, Application No. 10090602 recites the system according to claim 41, wherein the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database. U.S. Patent No. 6,546,005 claim 28 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

c. a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database;

wherein information corresponding to the user's preferred communications options is automatically learned in accordance with how the user interacts with communication attempts from other persons and **wherein the information stored in the cache for a particular subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database**. Therefore, claim 28 of U.S. Patent No. 6,546,005 includes the limitation of claim 42 of Application No. 10090602.

Referring to claim 43, Application No. 10090602 recites an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

a. a computer;

b. a database, linked to the computer, containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred communications options;

wherein the information corresponding to the user's preferred communications options includes information received over a communications link from a personal information source associated with the user. U.S. Patent No. 6,546,005 claim 36 recites the system according to claim 28, wherein the information corresponding to the user's preferred communications options includes information received over a communications link from a personal information source associated with the user. Therefore, claim 43 of Application No. 10090602 includes the limitation of claim 36 of U.S. Patent No. 6,546,005.

Referring to claim 44, Application No. 10090602 recites a method of operating an active user registry service accessible over a communications network, comprising the steps of:

a. receiving a request for communications contact information corresponding to a user;

b. searching a database containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred communications options; and

c. determining a communications address for contacting the user in accordance with a comparison between a communications option accompanying the

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request and the user's preferred communications options. U.S. Patent No. 6,546,005 claim 38 recites a method of operating an active user registry service accessible over a communications network, comprising the steps of:

- a. receiving a request for communications contact information corresponding to a user;
- b. searching a database containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred one or more communications options; and
- c. determining a communications address for contacting the by brokering a communication in accordance with a comparison between a communications option accompanying the request and the user's preferred communications options; and
- d. converting a communication for the user into a form receivable by the user over at least one of the user's preferred communications options, including converting text portions of a facsimile message into a voice message.

Application No. 10090602 claim 44 does not claim brokering a communication in accordance with a comparison between a communications option accompanying the request and the user's preferred communications options; and

- d. converting a communication for the user into a form receivable by the user over at least one of the user's preferred communications options, including converting text portions of a facsimile message into a voice message. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made

to omit from claim 38 of U.S. Patent No. 6,546,005 brokering a communication in accordance with a comparison between a communications option accompanying the request and the user's preferred communications options; and

d. converting a communication for the user into a form receivable by the user over at least one of the user's preferred communications options, including converting text portions of a facsimile message into a voice message because the scope of U.S. Patent No. 6,546,005 claim 38 is broader than claim 44 of the instant Application No. 10090602.

Referring to claims 45-56, Application No. 10090602 claims 45-56 are identical to claims 39-50 respectively of U.S. Patent No. 6,546,005.

Referring to claim 57, Application No. 10090602 claim 57 recites the method according to claim 44, further comprising the step of converting a communication for the user into a form receivable by the user over at least one of the users preferred communications options. U.S. Patent No. 6,546,005 claim 38 recites U.S. Patent No. 6,546,005 claim 38 recites a method of operating an active user registry service accessible over a communications network, comprising the step of:

d. **converting a communication for the user into a form receivable by the user over at least one of the user's preferred communications options,** including converting text portions of a facsimile message into a voice message.

Therefore, the limitation of claim 57 of Application 10090602 is included in claim 38 of U.S. Patent No. 6,546,005.

Referring to claim 58, Application No. 10090602 claim 58 is identical to claim 51 of U.S. Patent No. 6,546,005.

Referring to claim 59, Application No. 10090602 claim 59 recites the method according to claim 57, wherein the step of converting a communication for the user into a form receivable by the user over at least one of the user's preferred communications options includes converting text portions of a facsimile message into a voice message. U.S. Patent No. 6,546,005 claim 38 recites U.S. Patent No. 6,546,005 claim 38 recites a method of operating an active user registry service accessible over a communications network, comprising the step of:

d. converting a communication for the user into a form receivable by the user over at least one of the user's preferred communications options, including converting text portions of a facsimile message into a voice message. Therefore, the limitation of claim 59 of Application 10090602 is included in claim 38 of U.S. Patent No. 6,546,005.

Referring to claim 60, Application No. 10090602 claim 60 includes the d. limitation of claim 58 of U.S. Patent No. 6,546,005.

Referring to claim 61, Application No. 10090602 claim 61 includes the d. limitation of claim 59 of U.S. Patent No. 6,546,005.

Referring to claim 62, Application No. 10090602 claim 62 includes the d. limitation of claim 60 of U.S. Patent No. 6,546,005.

Referring to claim 63, Application No. 10090602 claim 63 includes the d. limitation of claim 61 of U.S. Patent No. 6,546,005.

Referring to claim 64, Application No. 10090602 claim 64 includes the d. limitation of claim 62 of U.S. Patent No. 6,546,005.

Referring to claims 65-70, Application No. 10090602 claims 65-70 are identical to claims 52-57 respectively of U.S. Patent No. 6,546,005.

Referring to claim 71, Application No. 10090602 claim 71 is included in the c. limitation of claim 28 of U.S. Patent No. 6,546,005.

Referring to claim 72, Application No. 10090602 claim 72 is included in the c. limitation of claim 28 of U.S. Patent No. 6,546,005.

Referring to claim 73, Application No. 10090602 claim 73 is identical to claims 17 and 64 of U.S. Patent No. 6,546,005.

Referring to claim 74, Application No. 10090602 claim 74 is identical to claims 18 and 65 of U.S. Patent No. 6,546,005.

Referring to claim 75, Application No. 10090602 claim 75 is identical to claims 19 and 66 of U.S. Patent No. 6,546,005.

Referring to claims 76-81, Application No. 10090602 claims 76-81 are identical to claims 67-72 respectively of U.S. Patent No. 6,546,005.

Referring to claim 82, Application No. 10090602 claim 82 recites a method of operating an active user registry service accessible over a communication network, comprising the steps of:

a. receiving a request for communication contact information corresponding to a user;

b. searching a database containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred communications options;

wherein the user's preferred communications options are automatically learned in accordance with how the user interacts to communications form other persons; and

c. determining from the database a communications address for contacting the user. U.S. Patent No. 6,546,005 claim 73 recites a method of operating an active user registry service accessible over a communications network, comprising the steps of:

a. receiving a request for communications contact information corresponding to a user by retrieving contact information form a cache maintained for a subscriber information corresponding to an entry point to communications information for contacting the user stored in the cache maintained for a subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database;

b. searching a database containing communications information for contacting the user including a user identifier, a plurality of communications addresses and information corresponding to the user's preferred one or more communications options; wherein information corresponding to the user's preferred communications options is automatically learned in accordance with how the user interacts with communications attempts form other persons; and

c. determining from the database a communications address for contacting the user.

Application No. 10090602 does not claim by retrieving contact information from a cache maintained for a subscriber information corresponding to an entry point to communications information for contacting the user stored in the cache maintained for a subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit from claim 73 of U.S. Patent No. 6,546,005 by retrieving contact information from a cache maintained for a subscriber information corresponding to an entry point to communications information for contacting the user stored in the cache maintained for a subscriber is updated in accordance with a pattern of communications options utilized over time by the subscriber upon access to the database because the scope of U.S. Patent No. 6,546,005 claim 73 is broader than claim 82 of the instant Application No. 10090602.

Referring to claims 83-91, Application No. 10090602 claims 83-91 are identical to claims 74-82 respectively of U.S. Patent No. 6,546,005.

Referring to claim 92, Application No. 10090602 claim 92 includes the a. limitation of claim 73 of U.S. Patent No. 6,546,005.

Referring to claim 93, Application No. 10090602 claim 93 includes the a. limitation of claim 73 of U.S. Patent No. 6,546,005.

Referring to claim 94, Application No. 10090602 claim 94 includes the limitation of claim 74 of U.S. Patent No. 6,546,005.

Referring to claim 95, U.S. Patent No. 6,546,005 claim 83 is broader than claim 95 of Application No. 10090602.

Referring to claims 96-101, Application No. 10090602 claims 96-101 are identical to claims 84-89 respectively of U.S. Patent No. 6,546,005.

Conclusion

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamal A. Fox whose telephone number is (571) 272-3143. The examiner can normally be reached on Monday-Friday 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 Customer Service whose telephone number is (571) 272-2600.

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Jamal A. Fox


WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER